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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,059	02/26/2002	Seiichi Miyanaga	219886US0DIV	3155

22850 7590 08/06/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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TRUONG, DUC

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/082,059

Applicant(s)

MIYANAGA ET AL.

Examiner

Duc Truong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10, 11 and 19-25 is/are allowed.
- 6) ☒ Claim(s) 6-9 and 12-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

Applicant's arguments filed 6/18/03 have been fully considered but they are not persuasive. The Amendment submitted by Applicant does not overcome the rejection made by Examiner in the last Office action.

Claims 6-9 and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu.

The rejection is maintained for the reasons as stated in the last Office action and for the following reasons:

Applicant's arguments are based on the use of different initiators, such as the use of a cationic initiator such as oxonium salt and a catalyst instead of any rare earth element to have the molecular weight of 10,000 or less. Said arguments have been fully considered but they are not persuasive since they are not commensurate in scope with the claims. Applicant further discloses a literature, Polymer Chemical Vol. 17, 179, page 175-177 to support for said arguments. They are not persuasive since there is no English language translation.

The following position is taken because the claims in this application are read as broadly as possible. Limitations from the specification or remarks as to how the polymers are produced are not read into the claims. The claims as presented are included in the broad teachings of the reference since they read on a polyether produced from any methods having the claimed number average molecular weight.

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Applicant has presented no factual evidence to show why the polyether of the reference would not in fact have the claimed number average molecular weight. The fact that the reference does not include said property is not viewed as a basis to infer that said property is not possessed by the polyether of the reference. The composition disclosed by the reference is prepared from reactants and under process conditions that are inclusive of the claimed reactants and conditions. In view of this similarity, it would appear to be inherent that a polyether having the claimed number average molecular weight could be prepared following the teachings of the reference. See *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

Claim ~~8~~<sup>12</sup> is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim ~~8~~<sup>12</sup> recites the limitation "a=0" in line 1. There is insufficient antecedent basis for this limitation in the claim.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Claims <sup>10, 11</sup>~~6-9~~ and <sup>19-25</sup>~~12-18~~ are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Truong whose telephone number is 703-308-2437. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



DT  
August 4, 2003

DUCTRUONG  
PRIMARY EXAMINER